REMARKS

In the Final Office Action[1], the Examiner provisionally rejected claims 8 and 18

under the judicially created doctrine of obviousness-type doubling patenting as being

unpatentable over claims 4, 12, and 19 of copending U.S. Patent Application

No. 10/676,374 ("the '374 application"); objected to claims 18-22; rejected claims 10-17

under 35 U.S.C. § 112, first paragraph; and rejected claims 1-22 under

35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub.

No. 2002/0108101 to Charisius et al. ("*Charisius*")

Applicants propose amending claims 10 and 18. Upon entry of this amendment,

claims 1-22 will remain pending in this application.

I. PROVISIONAL DOUBLE PATENTING REJECTION

Applicants respectfully traverse the non-statutory double patenting rejection of

claims 8 and 18. Applicants request that the Examiner continue to hold the rejection in

abeyance for at least the reason that no actual double-patenting circumstance can arise

until a patent issues from the present application or the '374 application. Upon review

of the remarks made in this paper, should the Examiner believe this application to be in

condition for allowance but for the double patenting rejections held in abeyance,

Applicants respectfully request that the Examiner contact the undersigned

representative to discuss an appropriate resolution.

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[1] The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

II. OBJECTION TO CLAIMS 18-22

The Examiner stated, "[c]laims 18-22 are objected to because . . . reciting 'first model' without a scenario that would otherwise clarify why a model is *first* . . . is deemed an improper use of language" (Final Office Action at page 5). Applicants propose to amend independent claim 18 to recite a "data model" instead of a "first model." Accordingly, Applicants respectfully request that the Examiner withdraw the objection to claims 18-22.

III. REJECTION OF CLAIMS 10-17 UNDER § 112, ¶1

Applicants respectfully traverse the rejection of claims 10-17 under 35 U.S.C. § 112, first paragraph. In the Final Office Action, the Examiner contends that the claims "fail[ ] to particularly point out and distinctly claim the subject matter which applicant[s] regard as the invention . . . [c]laim 10 recites the limitation 'such that the API' . . . There is insufficient antecedent basis for this limitation" (Final Office Action at page 5). Applicants propose to amend independent claim 10 to recite "the XML schema" instead of "the API schema." Therefore, Applicants request that the Examiner reconsider and withdraw rejection of claims 10-17 under 35 U.S.C. § 112, first paragraph.

IV . REJECTIONS UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 1-22 under

35 U.S.C. § 103(a) as being unpatentable over *Charisius*. A *prima facie* case of

obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear

articulation of the reason(s) why the claimed invention would have been

obvious . . . [R]ejections on obviousness cannot be sustained with mere conclusory

statements." *See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "The mere fact that

references <u>can</u> be combined or modified does not render the resultant combination

obvious unless the results would have been predictable to one of ordinary skill in the

art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation*

omitted. Moreover, "[i]n determining the differences between the prior art and the

claims, the question under 35 U.S.C. § 103 is not whether the differences <u>themselves</u>

would have been obvious, but whether the claimed invention <u>as a whole</u> would have

been obvious." *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under

35 U.S.C. § 103(a) is stated in Graham v. John Deere Co., 383 U.S. 1, 148

U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and

content of the prior art and] . . . [a]scertaining the difference between the claimed

invention and the prior art." *M.P.E.P. § 2141(II)*. Office personnel must explain why the

difference(s) between the prior art and the claimed invention would have been obvious

to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*.

Independent claim 1 recites, in part,

> receive a first model in a first language, the first model
> defining development objects representing building blocks
> for developing the application, relationships among the
> development objects, and constraints for developing the
> application"
>
> generate a set of intermediate objects using the first model;
> and
>
> generate an API using the set of intermediate objects as
> inputs such that the API enforces the relationships and the
> constraints defined in the first model and enables accessing
> the development objects

(emphasis added).

The Examiner alleges that *Charisius* discloses "receive a first model in a first language" (Final Office Action at page 6). Specifically, the Examiner alleges that a "graphical view of language representation . . . **reads on** model being in first language" (emphasis in the original) (Final Office Action at page 6). Even if a "graphical view of language representation" corresponds to a "model being in first language," it does not demonstrate that *Charisius* teaches or suggests "receiv[ing] a first model in a first language," as recited in claim 1.

Charisius discloses a "software development tool that creates a graphical representation of source code" (paragraph 0057). *Charisius* further discloses, the "graphical representation of the project may be in Uniform Modeling Language . . . developer . . . uses the software development tool to open a file which contains [the] . . . source code" (paragraphs 0088-0089). *Charisius* discloses "creat[ing] a graphical representation of source code" and, in particular, "software development tool generates a transient meta model (TMM) 200 which stores a language neutral

representation of the source code 202. The graphical 204 . . . representations of the source code 202 are generated from the language neutral representation in the TMM 200 . . . all modifications are made directly to the source code . . . and the TMM 200 is used to generate the modifications in the graphical 204 . . . views from the modifications to the source code" (emphasis added) (paragraphs 0057-0058). Generating a graphical view from language neutral representation in the TMM (model) does not teach or suggest "receiv[ing] a first model" (emphasis added), as recited in claim 1.

Furthermore, the Examiner alleges that "standardized UML notations and language rules reads on constraints between UML objects" (Final Office Action at page 6). Even if the Examiner's allegations are correct, which the Applicants do not concede, "constraints between UML objects" does not constitute "constraints for developing the application" (emphasis added), as recited in claim 1.

The Examiner also seems to allege that *Charisius* discloses "generate a set of intermediate objects using the first model," as recited in claim 1 (Final Office Action at page 7). This is also not correct.

Charisius further discloses, after "opening a file which contains existing source code . . . or creat[ing] a file in which the source code will be developed[,] . . . the software development tool then obtains a template for the current programming language in which the source code is written . . . that can be used to build the data structure . . . The software development tool uses the template to parse the source code . . . and create the data structure" (paragraph 0089). Fig. 5 depicts a data structure of the language neutral representation of the source code in Fig. 4 (paragraph 0060). None of creating a data structure by using a template to parse

source code, generating <u>a TMM (model) of (using)</u> the <u>source code</u>, or generating a <u>graphical view from (using)</u> the language neutral representation in the <u>TMM</u>, as disclosed by *Charisius,* teach or suggest "generat[ing] a set of intermediate <u>objects using a first model</u>" (emphasis added), as recited in claim 1.

The Examiner also seems to allege that *Charisius* discloses "using the packages from derived template and class symbols represented in UML model, along with graphical view of code objects to generate a[ ] metamodel within interface 610, including instance of RWI, IDE or SCI," and the Examiner alleges that it "**reads on** using intermediate objects to create one such API being instantiated" as recited in claim 1 (emphasis in the original) (Final Office Action at page 7). This allegation is also incorrect for at least the following reasons.

Charisius further discloses, the software development "tool 610 comprises . . . an open application program interface (API), and modules 704 . . . There are three main packages composing the API 702: IDE, RWI, and SCI (paragraph 0064). A "package is a collection of attributes, notifications, operations, or behaviors that are treated as a single module or program unit" (paragraph 0064). For example, "IDE 708 is the API needed to generate custom outputs based on information contained in a model" (paragraph 0065). The Examiner provides other examples of "using the API instance" (Final Office Action at page 7). However, none of the examples teaches or suggests "generate an API using the set of intermediate objects as inputs such that the API enforces the relationships and the constraints defined in the first model and enables accessing the development objects," as recited in claim 1.

First, *Charisius* does not disclose or suggest using UML model, along with graphical view of code objects to generate a metamodel within interface 610, including instance of RWI, IDE or SCI, as alleged by the Examiner. *Charisius* discloses that IDE, RWI, and SCI are packages that comprise the API and are not metamodels, as alleged by the Examiner. Furthermore, converting the <u>source code</u> into the language-neutral representation in the TMM (transient meta model) (*Charisius* paragraph 0064), does not constitute or suggest "using . . . <u>UML model, along with graphical view of code objects to generate a metamodel</u>" (emphasis added), as alleged by the Examiner.

Second, *Charisius* does not disclose or suggest generating an API. Rather, the "software development tool comprises" an API composed of an IDE, RWI, and SCI. *Charisius* discloses <u>using</u> the API and its components, IDE, RWI, and SCI, as part of the software development tool, not generating an API or any of its components. Accordingly, *Charisius* does not teach or suggest "<u>generat[ing] an API</u> using the set of intermediate objects" (emphasis added), as recited in claim 1.

In view of at least the above deficiencies of the *Charisius* reference, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Accordingly, the Examiner has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1, and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Claims 10 and 18, though of different scope than claim 1, recite similar elements, and are thus allowable over *Charisius* for at least the same reasons as claim 1.

Claims 2-9, 11-17, and 19-22 depend from claims 1, 10, and 18, respectively, and are thus allowable over *Charisius* for at least the same reasons as claim 1.

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. It is respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.
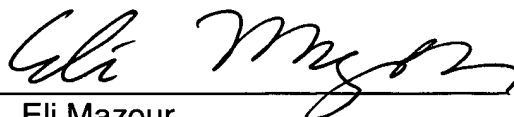
In view of the foregoing remarks, Applicants requests the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 20, 2008   By: _____

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